



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/415,795	10/08/99	ZHOU	HMV-043.01

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EXAMINER
SLOBODYANSKY, E

ART UNIT	PAPER NUMBER
1652	12

DATE MAILED: 03/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/415,795

Applicant(s)
Zhou et al.

Examiner
Elizabeth Slobodyansky

Group Art Unit
1652



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-35 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claims 1-35 are pending.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a method for targeting degradation of a polypeptide using a ubiquitin ligase, classified in class 435, subclass 68.1.
- II. Claims 16-21 and 23-31, drawn to a DNA encoding an SCF domain fusion protein, a vector and a method of use thereof, classified in class 435, subclass 69.7.
- III. Claim 22, drawn to a method for creating a destabilized polypeptide, classified in class 530, subclass 402.
- IV. Claims 32-35, drawn to a method of treating with an inhibitor, classified in class 514, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

Methods of inventions I, III and IV are patentably distinct because they are drawn to materially different methods. A method of invention I is a method of use of a transformed cell (DNA) whereas a method of invention III employs non-recombinant techniques such as chemical synthesis, for example, for making a fusion protein and a

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method of invention IV is a method of use of an inhibitor. An inhibitor used in invention IV is neither used nor produced by methods of inventions I and III.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case a method for targeting degradation can be practiced with ligases other than an SCF and a DNA encoding an SCF fusion can be used for the production of said fusion.

Claims 1-5, 14 and 15 are generic to a plurality of disclosed patentably distinct species comprising (a) an SCF (claims 6-11), (b) a HECT (claim 12), (c) a UBR1 polypeptide (claim 13). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. If applicants will elect the species of an SCF, further election of a single species from SEQ ID Nos: 2, 4, 6, 8, 10 and 12 is required.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Dr. Isabelle Clauss on March 20, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

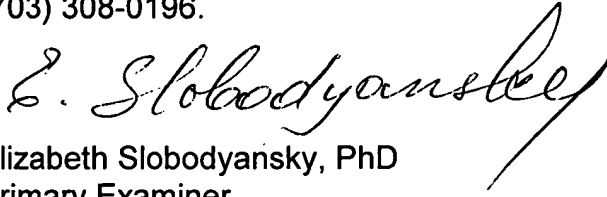
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is (703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, reading "E. Slobodyansky". The signature is written in black ink and is positioned above the printed name and title.

Elizabeth Slobodyansky, PhD
Primary Examiner

March 20, 2001